

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 20-30, 32-35, and 39-41 are pending in this application when last examined and stand rejected.

The claims have been amended in a non-narrowing manner to make minor editorial revisions to better conform to U.S. claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include: replacing the "characterized by" language with "wherein"; revising the claim language to provide proper antecedent basis throughout the claims. No new matter has been added.

Applicants note that the above claim amendments are intended to address matters of form only as they are not intended to affect the scope of the claims. Accordingly, if the next Office Action on the merits includes a new ground of rejection of one or more claims, the Action must be non-final.

II. PRIOR ART REJECTIONS

Claims 23-28, 30, and 39-41 were rejected under 35 U.S.C. § 103(a) as obvious over SUYDAM in view of DYE and further

in view of BORTLE and NOZAKI for the reasons items 3-13 on pages 2-6 and in item 24 on pages 9-10 of the Office Action.

Claims 29-30 were rejected under 35 U.S.C. § 103(a) as obvious over SUYDAM in view of DYE, BORTLE and NOZAKI and further in view of MCWHORTER and PERRSON for the reasons items 14-17 on pages 6-7 and in item 24 on pages 9-10 of the Office.

Claims 32 was rejected under 35 U.S.C. § 103(a) as obvious over SUYDAM in view of DYE, BORTLE and NOZAKI and further in view of GRIFFITTS for the reasons items 18-19 on pages 7-8 and in item 24 on pages 9-10 of the Office.

Claim 33 was rejected under 35 U.S.C. § 103(a) as obvious over SUYDAM in view of DYE, BORTLE and NOZAKI and further in view of OXLEY for the reasons items 20-21 on pages 8-9 and in item 24 on page 9 of the Office.

Claims 34-35 were rejected under 35 U.S.C. § 103(a) as obvious over SUYDAM in view of DYE, BORTLE and NOZAKI and further in view of OXLEY for the reasons items 20-21 on pages 8-9 and in item 24 on page 9 of the Office.

These rejections are respectfully traversed and will be discussed together below, since SUYDAM is the primary reference used throughout.

As all of the claims depend from claim 23, directly or indirectly, it is believed that the argument in favor of patentability of claim 23 suffices for all of the claims.

Despite Applicants' arguments in the last response, the Office seems to persist in rejecting the claims, arguing the claims are allegedly obvious over certain of the previously cited references and now even further in view of newly cited Nozaki.

Applicants respectfully disagree and traverse these rejections, since none of the cited documents discloses or suggests the urological measuring instrument of independent claim 23. Accordingly the measuring instrument of the invention is deemed novel and non-obvious over the cited prior art.

In support thereof, it should first be noted that despite the extensive prior art cited against the corresponding European patent application no. 03 782 982, the European Patent Office now intends to grant a European patent based on a claim almost identical to claim 23.

The present invention of claim 23 is concerned with a urological measuring instrument for measuring a urine flow which is convenient in use and has a compact storage state, with components of the instrument lying at least substantially folded onto each other with respective external surfaces facing each other and being substantially flush with each other.

As indicated in the last response, the cited prior art references fail to disclose or suggest such a specific urological measuring instrument.

Again, Suydam does not disclose a urological measuring instrument capable of assessing urine flow. Suydam only discloses is a collection device for urine which may be convenient for a person experiencing the need to eliminate urine. There is no disclosure or suggestion anywhere in Suydam of providing such a device with flow indicator for assessing urine flow. In the neck portion (30) of the flannel (28) there is no disclosure to comprise such indicator or even to be capable of indicating a magnitude of the urine flow.

Though the flannel of Suydam can be brought from a compact storage state to an expanded ready-to-use state by folding the rim component of the flannel, Suydam gives no indication nor any suggestion to fold the components of the collection device onto each other in the storage state. Only the flannel is folded into the storage bag in the storage state. The present invention is hence clearly novel over Suydam.

A combination of Suydam with any of the other cited documents, particularly Dye, will still not result in the instrument according to claim 23.

Dye does not disclose a foldable and disposable article. Combining the receiving member of Suydam with the measuring instrument of Dye would not render a device which is foldable as a whole as a disposable article formed substantially of flexible material. This combination would teach a skilled person only to add the rigid tubular indicator means of Dye to

the receiving member of Suydam in order to provide measuring capabilities. The combination does not teach the skilled person how the rigid indicator means of Dye could be conceived as a foldable measuring instrument that has a compact storage state and hence can be carried conveniently and discreetly by a user. In view of the above the instrument according to claim 23 is both novel and non-obvious over the combination of Suydam and Dye.

Even the Office admits that the primary reference of Suydam in combination with Dye and further in view of Bortle does not disclose such an instrument, in particular the components of the instrument lying at least substantially folded onto each other with respective external surfaces facing each other and being substantially flush with each other as in claim 23. Nonetheless, according to the Office it would allegedly have been obvious to one of ordinary skill in the art at the time the invention was made to combine Suydam, Dye and Bortle even further with Nozaki.

Applicants respectfully disagree and submit that Nozaki fails to remedy the above-noted deficiencies in Suydam, Dye and Bortle.

In this regard, Nozaki also fails to disclose or suggest the urological measuring instrument of claim 23. Further, Nozaki is merely concerned with an absorbent bag which can be used by a person to receive and absorb any unintentional urine spill. Urological measuring instruments and urine absorbent bags

clearly belong to a different technical field. It is therefore deemed non-obvious for one of ordinary skill in the art of urological measuring instruments to combine such documents relating to different technical fields as there would be no suggestion or advantage to do so.

But even if such references were combined, it is believed that such combination would not result in the instrument according to claim 23.

In this respect, Nozaki does not disclose nor suggest the flow indicator of the claims. All that Nozaki teaches is a receiving member for urine spill. This does not teach the skilled person how to bring the measuring device of Dye, which is the only disclosure of a measuring device with a flow indicator, into a compact storage state with components, e.g. the rigid indicator means and receiving member, lying at least substantially folded onto each other with external surfaces facing each other and being substantially flush with each other. Nozaki would at most teach the skilled person that the receiving member of Dye may be folded.

Thus, Applicants submit that the combined cited references fail to disclose or suggest each and every element of claim 23.

It is well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one

skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. See, *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

Thus, since the combined cited references fail to disclose or suggest a urological measuring instrument in which components may be folded onto each other with respective external surfaces facing each other and being substantially flush with each other, claim 23 is deemed both novel and non-obvious over the cited prior art.

Thus, withdrawal of the above 103(a) obviousness rejections is requested.

In the event that the Examiner disagrees and maintains the rejections, Applicants would appreciate the opportunity to interview the Examiner discuss such before the issuance of another Action. Applicants will shortly contact the Examiner to arrange a telephonic interview.

III. CONCLUSION


In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Jay F. Williams, Reg. No. 48,036
209 Madison Street, Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

JFW/jr